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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/620,549 | 07/16/2003 | Peter Seitz | 13027.43US01 | 8444 |

23552 7590 03/09/2006

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EXAMINER

DICUS, TAMRA

| ART UNIT | PAPER NUMBER |
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1774

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/620,549 | Applicant(s) SEITZ, PETER | |
| | Examiner Tamra L. Dicus | Art Unit 1774 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>01-09-05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgement is made of the IDS. The cancellation of claims 3 and 12 are acknowledged.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2, and 4-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims refer to a pressure-distribution pattern and a two-dimensional sampling. However, neither term is described with enough detail to show or explain how the application of the identification device or the device itself is produced, specifically no sufficient description exists on how patterns are formed or images obtained by taking “the means of the pressures”, or “during walking”, “sitting, grabbing”, or what the “special method” is that generates the two-pressure distribution patterns shown in Fig. 1 and 2 (see Applicant’s specification at page 5, line 24-31) or how “different high pressures are represented by area elements that are shaded in different ways or colors” or how “a movement sequence is abolished”. It is not clear from the specification how pattern-distributions are taken while one is actively walking. The instant specification does not describe how the pressures are “represented” by colors and shades. For example, see Applicant’s specification at page 3, line 10-33, and page 5, line 26. How does

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sampling of pressure distribution comprise a plurality of scans? How is this generated? See page 3, lines 18-25. It is not clear what method or device is used to produce the patterns or sampling or different colored or shaded areas. The instant specification does not explain in sufficient detail what makes the difference of the colors or shading in different ways. Thus, one skilled in the art would not know how to make the invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2, and 4-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims recite a “personal item configured to be worn”, “different high pressures are represented” and that a “movement sequence... is abolished” (instant claim 4) or how an application of an identification device as claimed wherein said pattern is obtained from a person who uses the identification device or during walking or grabbing; this language is not clear and is indefinite. Further the claims appear somewhat misleading or conflicting because the instant specification at page 3, line 34 states “such an identification device, i.e. such an image”, and the claims contain language to movement and sampling. What is “a contact” and “movement sequence is established and abolished”? Thus it is not clear if the claims are to the actual device that senses the pressure distribution or an image that senses the pressure as claimed. It is unclear as to what applicant intends from the language as claimed as recited in claims 1-11.

The term “high” in claims 1 and 2 is a relative term which renders the claim indefinite. The term “high” is not defined by the claim, the specification does not provide a standard for

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ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. How high is high?

To claim 9, that the pattern obtained “is of” a sitting surface is not clear as to what this means.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2, 4-11 are rejected under 35 U.S.C. 102(b) are anticipated as described at www.novel.de.

3. Novel teaches a system and apparatus calculating two and three-dimensional pressure distribution taken in static and dynamic locomotion (pressure distribution occurring during a movement sequence) printed out via computer, printer and software. See the invention sold at www.novel.de dated 3/23/00. See MPEP 706.02(c) and 2133.03. That the personal item is “configured to be worn on a persons body” is to intended use, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Claims 1-2 and 4-11 are met.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,454,600 to Floyd in view of USPN 6,331,893 to Brown et al.

Floyd teaches an infinite array of images may be contained in an identification label (col. 4, lines 27-30) on substrates such as fabric, plastic, an article of clothing such as a shirt, or similar materials (equivalent to a personal item and cloth, col. 3, lines 25-28, col. 4, line 35). The printed image is applied to a designed label, ironed on a shirt for the purpose of identifying the child during an abduction. See col. 1, lines 5-20 and lines 40-65, col. 2, line 3, lines 20-35 (instant claims 1-2, 6-7, 11).

However, Floyd does not teach an image having two-dimensional sampling of a pressure distribution wherein differently colored and different shaded elements are present (instant claims 1-2, 6-8, 11).

Brown teaches an identification device such as a foot analyzer that senses pressure differences and distribution generating data points of all sides of a foot to display two-dimensional bar graphs (image) of one to many different colors varying with pressure levels and the analyzer is able to record and print out the test results and the information on the screen via a printer and computer (Abstract, col. 3, lines 35-50, col. 12, lines 32-65, col. 17, lines 20-25, and lines 60-65).

Thus, it would have been obvious to one having ordinary skill in the art to have modified the identification label of Floyd to add the two-dimensional printout image of Brown because Floyd suggests attaching any printed image to a personal item and Brown teaches an identification device such as a foot analyzer that senses pressure differences and distribution generating data points of all sides of a foot to display two-dimensional bar graphs (image) of one to many different colors varying with pressure levels and the analyzer is able to record and print out the test results and the information on the screen via a printer and computer (Abstract, col. 3, lines 35-50, col. 12, lines 32-65, col. 17, lines 20-25, and lines 60-65). Thus, in combination, Applicant's invention is taught.

Further regarding claims 4-5 and 8-11, the combination does not expressly teach how the pressure-distribution pattern is obtained via walking, or sitting, or grasping, however such limitations are product by process limitations. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. The same process and materials of the instant product are provided by the prior art, and are hence considered equivalent. Further to claims 9-10 the patterns appear to happen only when something else happens, so it is not a requirement but a suggestion that appears time dependent. Language that suggests or makes optional but does not require steps to be

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performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. See MPEP 2106. Further to claims 4-5 and 8, that the pattern is obtained under motion or a foot during walking is within well within the purview of one having ordinary skill in the art given the same pattern distribution is obtained in view of the teachings of Brown.

Depending upon how slow one flexes the foot from heel-to-toe, which would constitute motion and walking on the foot analyzer of Brown, a pressure distribution pattern would be generated and developed in the same way, absent any evidence to the contrary. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

In re Boesch, 617 F.2d 272.

Claims 4-5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,454,600 to Floyd in view of USPN 6,331,893 to Brown et al. and further in view of USPN 6,345,839 to Kuboki et al.

To the interpretation that occurrence of movement as described per instant claims 4-5 and 9 happens, this combination is applied below.

As set forth above, the combination suggests pattern distribution from a foot.

Kuboki teaches a seating sensor in combination with a foot sensor that produces two-dimensional patterning (col. 3, lines 20-25, lines 55-60 having peaks (col. 4, line 10), FIG. 21-22 show the different peaks and valleys and different shading (instant claim 5)), where the occupant leans back (movement) on the seat sensor (col. 6, lines 20-50) and the sensor measures the pressure accordingly.

It would have been obvious to one having ordinary skill in the art to have modified the combination to include pressure distribution patterns generated from movement, having peaks and valleys, and sitting because Kuboki teaches a seating sensor in combination with a foot sensor that also produces two-dimensional patterning (col. 3, lines 20-25, lines 55-60 having peaks (col. 4, line 10), FIG. 21-22 show the different peaks and valleys and different shading (instant claim 5)), where the occupant leans back (movement) on the seat sensor (col. 6, lines 20-50) and the sensor measures the pressure accordingly.

Claims 1-2, and 4-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,454,600 to Floyd in view of USPN 6,735,547 to Yfantis.

To the interpretation that occurrence of a hand motion as described per instant claim 10 happens, this combination is applied below.

Floyd teaches an infinite array of images may be contained in an identification label (col. 4, lines 27-30) on substrates such as fabric, plastic, an article of clothing such as a shirt, or similar materials (equivalent to a personal item and cloth, col. 3, lines 25-28, col. 4, line 35). The printed image is applied to a designed label, ironed on a shirt for the purpose of identifying the child during an abduction. See col. 1, lines 5-20 and lines 40-65, col. 2, line 3, lines 20-35 (instant claims 1-2, 6-7, 11).

However, Floyd does not teach an image having two-dimensional sampling of a pressure distribution wherein differently colored and different shaded elements are present (instant claims 1-2, 6-8, 11).

Yfantis teaches at least two-dimensional patterning of a foot, or other parts of a body such as a hand generated via a foam member apparatus where the differently colored image is

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printed with the use of software (col. 1, lines 35-55, col. 3, lines 20-39, col. 6, lines 50-60, FIG. 9-10).

Thus, it would have been obvious to one having ordinary skill in the art to have modified the identification label of Floyd to add the at least two-dimensional printout image of Yfantis because Floyd suggests attaching any printed image to a personal item and Yfantis teaches at least two-dimensional patterning of a foot, or other parts of a body such as a hand where the differently colored image is printed with the use of software (col. 1, lines 35-55, col. 3, lines 20-39, col. 6, lines 50-60, FIG. 9-10). Thus, in combination, Applicant's invention is taught.

Further regarding claims 4-5 and 8-11, the combination does not expressly teach how the pressure-distribution pattern is obtained via walking, or sitting, or grasping, however such limitations are product by process limitations. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. The same process and materials of the instant product are provided by the prior art, and are hence considered equivalent. Further to claims 9-10 the patterns appear to happen only when something else happens, so it is not a requirement but a suggestion that appears time dependent. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. See MPEP 2106. Further to claims 4-5 and 8, that the pattern is obtained under

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motion or a foot during walking is within well within the purview of one having ordinary skill in the art given the same pattern distribution is obtained in view of the teachings of Yfantis.

Depending upon how slow one flexes the foot from heel-to-toe, which would constitute motion and walking on the foot member apparatus of Yfantis, a pressure distribution pattern would be generated and developed in the same way, absent any evidence to the contrary. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272.

PRIOR ART OF INTERST

USPN 6360598 teaches peaks and valleys of two and three dimensional patterns in FIG. 1-3.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues the 112 rejections. Within the art of sensors, there are a multitude of different ways to sense pressure or force. Although Applicant points to a couple of websites that generate pressure distribution patterns and mentions a “special method” of obtaining the specific patterns referenced in the specification at page 5, line 26, Applicant has not described in sufficient detail how they make the invention. Simply referencing devices or images does not teach one how Applicant makes the invention. The instant specification is absent a teaching of how different colors or shades are obtained or how high pressures and mean and peak values are obtained, etc in such a way to make the invention without undue experimentation. There are no examples that correlate the image printouts to the “different high pressures” or “differently colored and area elements shaded in different ways”. A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. In re Wright, 999 F.2d 1557,1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). See MPEP 2164. The 112 rejections are maintained for reasons of record.

Floyd is still used to teach application of any images for the purpose of providing identification of a person and for application of the identification onto paper and/or ironed on to a T-shirt. The new art is to the pressure distribution technique of the amended claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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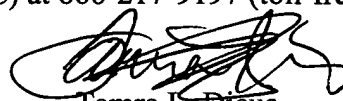
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 26, 2006



Tamra L. Dicus
Examiner
Art Unit 1774



RENA DYE

SUPERVISORY PATENT EXAMINER

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